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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,058	02/18/2004	John Pafford	MSDI-455/PC263.33	8377

52196 7590 03/18/2010
MEDTRONIC
Attn: Noreen Johnson - IP Legal Department
2600 Sofamor Danek Drive
MEMPHIS, TN 38132

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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03/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of:
PAFFORD, JOHN et al
Serial No.: 10/781,058
Filed: Feb. 18, 2004
Docket: MSDI-455/PC263.33
Title: BONE GRAFTS

DECISION ON PETITION

This is a decision on the Petition for Suspension of Action received on March 8, 2010, seeking to suspend action on the above-identified application for a period of six months. This petition is being considered pursuant to 37 CFR § 1.103(a)¹. The requisite petition fee under 37 CFR § 1.17(g) was paid.

The petition is denied.

In the petition, petitioner alleged that the petition to suspend further action on the current application is to provide sufficient time for a decision on petition by the USPTO in the abandoned application, SN 08/740,031. Petitioner requests suspension of action on the present application for six (6) months. Petitioner also opines that further examination of the present application may depend in part upon resolution of the petition in the abandoned related application SN 08/740,031. A suspension of action in the present case will prevent potentially unnecessary activity in the current application which would be wasteful of Office resources.

The reason stated in the petition for suspension of Office action is not justified. Under 37 CFR § 1.103(a), the Office will not suspend action if a reply by applicant to an Office action is outstanding. There was a non-final Office action mailed on December 11, 2008. The applicant must file a complete response to the non-final Office action of December 11, 2008 within the statutory period to respond. Therefore, the requested suspension will not be granted.

¹ 37 CFR 1.103. Suspension of action by the Office. (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office


Furthermore, the reason for a six-month suspension of action is not convincing and could not justify a six-month delay in prosecution. It is not clear why further examination of the present application would depend in part upon resolution of the petition in an abandoned application which was abandoned more than ten years. It is also not clear why suspension of action in the present case will prevent potentially unnecessary activity in the current application which would be wasteful of Office resources. However, the Office must balance the burden of timely examinations and needs of the public to know which claims it faces with the needs of applicants in pursuing claims which reflect the scope to which they are entitled. Therefore, any suspension of Office action will not be granted without a good and sufficient cause. Accordingly, the request for suspension of action is denied.

The application remains in active status and is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3738 awaiting the applicant's complete response to the outstanding Office action of December 11, 2008. As stated in 37CFR § 1.181(f): The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR § 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DENIED.



Robert Olszewski, Director
Technology Center 3700